IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.:	09/385,394	Confirmation No.:	9093
Applicant:	John S. Yates, Jr., et al.		
Title:	COMPUTER WITH TWO EXECUTION MODES		
Filed:	August 30, 1999		
Art Unit:	2183		
Examiner:	Richard Ellis		
Atty. Docket:	114596-03-4000		
Customer No.	38492		

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By this paper, Applicant responds to the Notice of Non-Compliant Appeal Brief of February 15, 2006.

The Notice was issued in error and no replacement Appeal Brief is required. The Decision of February 10, 2006 (hereinafter, the "Extension Decision") on a Conditional Petition for a Request for Extension of Time of 11/28/2005 (hereinafter the "Extension Petition") states that the Patent Office considered the extension of time issue "moot" – that is, the Office **no longer contests** all issues raised in the Extension Petition. Although the wording used in the Extension Decision is somewhat unconventional, the effect of the Extension Decision was to accept an obligation to cease all violations alleged, and to grant all relief requested in the Extension Petition.

Because of the concessions in the Extension Decision, no Appeal Brief from Applicant is currently required. Prosecution is reopened and the paper of 4/25/2005 is entered as a Rule 111 Response to Office Action, or all extensions of time requested are granted.

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on June 13, 2006 as First Class Mail in an envelope with sufficient postage addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

David E. Boone

I. Background

A paper was filed on 11/28/2005, captioned "Response to Office Action, or in the Alternative, Appeal Brief." This paper notes several times that it is primarily submitted as a Response to Office Action (under 37 C.F.R. § 1.111(a)(1)), and only in the alternative, in the event and after all Petitions relating to premature final rejection are finally denied, as an Appeal Brief.

Also on 11/28/2005, a Petition for Extension of Time was filed. The Petition sought relief as follows:

> Action by the Office on the merits should be suspended until all issues raised in the Petition to Withdraw Finality are fully and fairly adjudicated. ...
>
> In the event that the Petition to Withdraw Finality is granted at either level, the finality of the Office Action of 10/25/2005 is withdrawn. All deadlines running from 10/25/2004 were tolled by the Response filed 1/25/2005. The Amendment filed 4/25/2005 is then entered by operation of law as a supplementary amendment, and the arguments provided in the "Response to Office Action, or in the alternative, Appeal Brief," may be considered in preparation of the next Office Action. All fees for extension of time were paid "in excess of that required," and may be refunded pursuant to 37 C.F.R. § 1.26(a).
>
> In the event that the Petition is finally denied, then Applicant's appeal brief or RCE should be due one month from the date that all petition process within the PTO is exhausted.

A Decision on the Petition for Extension of Time was issued on 2/10/2005. This Decision dismisses the extension request as "moot."

A separate Decision on Petition of February 10, 2006 (hereinafter, the "Finality Decision") addressed some – but by no means all – issues relating to "premature finality." The Finality Decision is not "final."[1]

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[1] In this paper, the T.C. Director stated noted that he had no jurisdiction to decide a number of issues. Once a tribunal decides that it has no jurisdiction, the Supreme Court instructs that the tribunal may not opine further. *Steel Company v. Citizens for a Better Environment*, 523 U.S. 83, 94 (1998) ("Without jurisdiction [no tribunal can] proceed at all in any cause. ... [W]hen [jurisdiction] ceases to exist, the only function remaining ... is that of announcing the fact and dismissing the cause.") The statements elsewhere in the Decision that certain requests for relief are "denied" were rendered without jurisdiction, and are thus nugatory.

II. Legal Preconditions and Consequences of "Mootness"

The Supreme Court and Federal Circuit have noted a large number of conditions that are either necessary preconditions, or necessary consequences, of any finding that an issue is moot. Among the most relevant are:

- The PTO states "with assurance that there is no reasonable expectation that the alleged violation will recur." *County of Los Angeles v. Davis*, 440 U.S. 625, 631 (U.S. Sup. Ct. 1979). Even if the PTO does not expressly concede that any alleged conduct was wrongful, it has taken steps to assure that all alleged violations will not recur.[2]

- No part of any request for relief remains outstanding, not even one of reduced importance, or issues that might be considered "collateral." The party asserting mootness waives all objection to all issues mentioned in proceedings below. *St. Paul Fire & Marine Ins. Co. v. Barry*, 438 U.S. 531, 537-38 (U.S. Sup. Ct. 1978); *Apotex v. Thompson*, 347 F.3d 1335, 1345-46 (Fed. Cir. 2003).

- Interim events have "completely and totally eradicated the effects of the alleged violation." *Los Angeles*, 440 U.S. at 631. Note that mootness is tested against a petitioner's mere "allegation." By asserting mootness, the PTO drops any contest to any allegation, and accepts responsibility for eradicating all effects.

- When a federal agency asserts mootness of a proffered request, it is "only because" the agency ceases all "offending conduct" by accepting the request. *Adarand Constructors Inc. v. Slater*, 528 U.S. 216, 221-22 (U.S. Sup. Ct. 2000).

- The burden of demonstrating mootness is the PTO's, not petitioner's, and it is a "heavy one." *Los Angeles*, 440 U.S. at 631.

- All judgments of the examiner or T.C. Director relating to closure of prosecution are vacated. *Deakins v. Monaghan*, 484 U.S. 193, 200 (U.S. Sup. Ct. 1988) ("the effect [of the] representations [of the party asserting mootness] and [any further] reliance thereon [have the following effects]... When a claim is rendered moot ..., the judgment below should be vacated... This disposition strips the decision below of its binding effect.").[3]

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[2] In particular, because this set of petitions arises out of a government entity's policy or practice of failing to abide by and enforce the terms of its own regulations (in this case, MPEP Chapter 2100 and MPEP § 706.07(c) (premature final rejection is petitionable, not appealable, "wholly distinct from the tenability of the rejection")) and precedents (*e.g.*, *In re Oku*, 25 USPQ2d 1155, 1157 (Comm'r Pats and TM 1992) ("A decision to reopen prosecution ... is a question solely within the discretion of the [Director] and is in no way a review of a merits decision ..., emphasis added)), a single instance of compliance does not render an issue moot – the issue is moot only when the PTO acknowledges that the policy and practice of rejecting claims without stating findings on all *prima facie* issues required by the MPEP, and premature final rejection after non-compliance, will stop. *Byrd v. U.S. Environmental Protection Agency*, 174 F.3d 239, 244-45 (D.C. Cir. 1999).

[3] The PTO may not assert mootness that might result from a petitioner's change in position "as a result of the very harassment they sought to restrain" by the petition. *A.Y. Allee v. Medrano*, 416 U.S. 802, 810 (U.S. Sup. Ct. 1974).

The Extension Decision on the extension petition asserts that the PTO has met all of these preconditions, and accepts all consequences. The legal status of the application in light of the Extension Decision is noted below.

III. Consequences of the Extension Decision of 2/10/2006

The Extension Decision has the following effects by operation of law. No further decision of any PTO official is required to confirm that these effects already exist:[4]

- No extension of time is required to allow further review of any Petition to Withdraw Finality – the Extension Decision states that the PTO offers no contest to all extensions of time required for full and final review of the premature final rejection issue.
- The PTO also has asserted that it has prospectively ceased all "offending conduct." That is, the Extension Decision states that the PTO will offer no contest to all requests for extensions of time extending through all steps of review.
- The PTO accedes to the following relief requested in the Extension Petition:

  > The Amendment filed 4/25/2005 is [ ] entered by operation of law as a supplementary amendment, and the arguments provided in the "Response to Office Action, or in the alternative, Appeal Brief," may be considered in preparation of the next Office Action. All fees for extension of time were paid "in excess of that required," and may be refunded pursuant to 37 C.F.R. § 1.26(a).

IV. Conclusion

The paper in the IFW dated 12/1/2005, 82 pages, currently designated "Appeal Brief Filed" should be redesignated "Response – After Non-Final Rejection."

All fees for extensions of time after the Response of 1/25/2005 were paid "in excess of that required," and may be refunded pursuant to 37 C.F.R. § 1.26(a).

In the alternative, the Extension Decision of 2/10/2006 announces that the PTO offers no contest to any requested extension of time, and such extension is granted by operation of law

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[4] Once the PTO asserts an issue is moot, it is "prevented from reviving" any claim it might have had relating to the issue. *Deakins*, 484 U.S. at 200 (the party asserting mootness "will be barred from reviving [its position] against [the other party] arising out the events surrounding [the matter declared moot]"). Having asserted mootness, the PTO has bound itself, and lacks the discretion to withdraw from the consequences of its action.

until a final decision on the issue of premature final rejection that "fully and fairly" treats all issues raised.

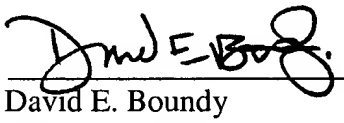
In view of reopening of prosecution, or extension of time running against this application, no petition for extension of time is necessary for entry of this paper.

Applicant respectfully submits that the application is in condition for examination, and requests a full and complete examination in compliance with all provisions of MPEP Chapter 2100 and 37 C.F.R. §§ 1.104, 1.11, and 1.113. Applicant submits that on such examination the application will be found to be in condition for allowance, and may be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: June 13, 2006

By: 

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